

Application Serial Number

8/709,930

DATE

INITIALS

Mail Personnel

Receive case and PALM in

Docket Personnel I

OB/Heard Classification

Outline case

Reviewers

Review/assign panel

Prepare order/remand

Docket Personnel I

Enter data in ACTS/PALM

Prep case (if panel assigned)

Docket Personnel I

Mail remand/order

Administrators

Assign Hearing Date

Docket Personnel II

Mail Notice of Hrg

Enter Hrg data in ACTS/PALM

Legal Technician

Typed decision

Enter data in ACTS/PALM

Docket Personnel I

Send case to

12/8/00

12/12/00

ELI

V/R

BOARD OF PATENT APPEALS  
AND INTERFERENCES

210 DEC -8 PM 2:43

RECEIVED

**DESIGNATION OF PANEL**

Pursuant to (1) the Commissioner's authority to designate the members of the Board of Patent Appeals and Interferences to hear cases before the Board (35 U.S.C. 7(b)), and (2) Commissioner Lehman's memorandum dated May 1, 1994 (delegating to the Chief Administrative Patent Judge the responsibility of designating members to hear cases before the Board), it is ORDERED that the panel of the Board of Patent Appeals and Interferences designated to hear this case shall consist of the following members of the Board:

☒ On Brief

☐ Heard

☐ Redesignation

☐ Expanded Panel,  
see addendum.

1.

Judge

Mesley

2.

Judge

McKelvey

3.

Judge

Lee

Bruce H Stoner Jr  
BRUCE H. STONER, JR.

Chief Administrative Patent Judge

Date of Hearing: \_\_\_\_\_



## UNITED STATES DEPARTMENT OF COMMERCE

## Patent and Trademark Office

Address: BOX INTERFERENCE

COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

MAILED

DEC 8 - 2000

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCESApplicant: GREEN  
Application No.: 08/709,930  
Filed: 09/09/96  
For: SURGICAL METHOD

Filed by: Judge Sally C. Medley

Telephone: (703) 308-9797

Facsimile: (703) 305-0942

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 104,644.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

  
SALLY C. MEDLEY  
Administrative Patent Judge

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 1

Filed by: Sally C. Medley  
Administrative Patent Judge  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

Filed 8 December 2000

MAILED

UNITED STATES PATENT AND TRADEMARK OFFICE

DEC 8 - 2000

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

YULUN WANG, KEITH P. LABY, DARRIN R. UECKER,  
AMANTE A. MANGASER, and MODJTABA GHODOUSSI

Junior Party,  
(Patent 5,878,193),

v.

PHILIP S. GREEN

Senior Party  
(Application 08/709,930).

Patent Interference No. 104,644

**NOTICE DECLARING INTERFERENCE**  
(37 CFR § 1.611)

**Part A. Declaration of interference**

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

**Part B. Judge designated to handle the interference**  
Administrative Patent Judge Sally C. Medley has been designated to handle the interference. 37 CFR § 1.610(a).

**Part C. Standing order**  
A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

**Part D. Conference call to set dates**  
A telephone conference call to set dates for taking action in the interference is scheduled for 10:15 a.m. on January 30, 2001 (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. The parties involved in this interference are:

Junior Party

Named inventors: Yulun Wang, Goleta, CA  
Darrin R. Uecker, Santa Barbara, CA  
Charles S. Jordan, Santa Barbara, CA  
James W. Wright, Santa Barbara, CA  
Keith Phillip Laby, Santa Barbara, CA  
Jeff D. Wilson, Santa Barbara, CA

Patent: U.S. Patent 5,878,193,  
granted 2 March 1999,  
based on application 08/732,015,  
filed 16 October 1996

Title: Automated endoscope system for optimal  
positioning

Assignee: Company Motion, Inc.

Accorded Benefit: Patent 5,878,193,  
granted March 2, 1999, based on  
Application 08/481,926,  
filed 6 June 1995

Application 08/167,704,  
filed 15 December 1993

Patent 5,524,180, granted  
4 June 1996, based on  
Application 08/072,982,  
filed 3 June 1993

Application 08/005,604,  
filed 19 January 1993

Application 07/927,801,  
filed 10 August 1992

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: Philip S. Green, Redwood City, CA

Application: Application 08/709,930  
filed 9 September 1996

Title: Surgical method

Assignee: None

Accorded Benefit: Application 07/823,932,  
filed 21 January 1992

Attorneys: See last page

Address: See last page

Part F. Counts and claims of the parties

Count 1

Claim 1 of 5,878,193<sup>1</sup>

The claims of the parties are:

Wang: 1-3

Green: 115, 118-126, 138, 139, 141 and 144

The claims of the parties which correspond to Count 1 are:

Wang: 1-3

Green: 115

The claims of the parties which do not correspond to Count 1 are:

Wang: none

Green: 118-126, 138, 139, 141 and 144

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<sup>1</sup> Claim 1 of 5,878,193 is identical to claim 115 of 08/709,930.

**Part G. Heading to be used on papers**

The following heading shall be used on papers filed in the interference. See § 18 of the STANDING ORDER.

Paper \_\_\_\_\_<sup>2</sup>

Filed on behalf of [name of party]

By: Name of lead counsel, Esq.

Name of backup counsel, Esq.

Street address

City, State, and Zip-Code

Tel:

Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Administrative Patent Judge Sally C. Medley)

YULUN WANG, KEITH P. LABY, DARRIN R. UECKER,  
AMANTE A. MANGASER, and MODJTABA GHODOUSSI

Junior Party,  
(Patent 5,878,193),

v.

PHILIP S. GREEN

Senior Party  
(Application 08/709,930).

Patent Interference No. 104,644

TITLE OF PAPER

<sup>2</sup> Leave a blank line because the board assigns the paper number.



## **Part H. Summary of dates for taking action**

Times for taking action are set out in the following sections of the STANDING ORDER:

1. § 7: date for identifying lead and backup counsel.
2. § 8: date for identifying any real party in interest.
3. § 9: date for requesting copies of involved and benefit applications and patents.
4. § 17: date for filing list of proposed preliminary motions.
5. § 19: date for accomplishing certain discovery.
6. § 20: date for filing clean copy of claims.
7. § 21: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
8. § 23: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
9. § 33: date for objecting to admissibility of evidence.
10. § 34: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11. § 35: dates when cross-examination can take place.
12. § 45: dates for taking action with respect to settlement discussions

**Part I. Order form for requesting file copies**

**FILE COPY REQUEST**

Interference 104,644

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

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Telephone, including area code: \_\_\_\_\_

Part J. Signature of administrative patent judge

  
SALLY C. MEDLEY  
Administrative Patent Judge

Date: 12/8/00  
Arlington, VA

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in  
the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in  
the testimony and briefing phases of the interference  
(ORDERTE6)

PTO Form 850 and statement by examiner

Copy U.S. Patent 5,878,193

Copy of claims of Green application 08/709,930

DECLARE.007  
Revised September, 2000  
(replaces DECLARE.006.1)

cc (via Federal Express):

Attorney for Wang:

Kenneth L. Stein  
Computer Motion  
130-B  
Cremona Drive  
Goleta, CA 93117

Attorney for Green:

Townsend and Townsend  
Two Embarcadero Center  
8th Floor  
San Francisco, CA 94111-3834

## INTERFERENCE DIGEST

Interference No. 104,644

Paper No. 38

Name: Philip S. Green

Serial No.: 08/709,930

Patent No.

Title: SURGICAL METHOD

Filed: 09/09/96

Interference with Wang et al.

### DECISION ON MOTIONS

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

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### FINAL DECISION

Board of Patent Appeals and Interferences, *Favorable* Dated, *3/30/02* *3/28/02*

Court, \_\_\_\_\_ Dated, \_\_\_\_\_

### REMARKS

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This should be placed in each application or patent involved in interference in addition to the interference letters.



## UNITED STATES DEPARTMENT OF COMMERCE

## Patent and Trademark Office

Address: BOX INTERFERENCE

COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

MAILED

DEC 8 - 2000

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Applicant: GREEN

Application No.: 08/709,930

Filed: 09/09/96

For: SURGICAL METHOD

Filed by: Judge Sally C. Medley

Telephone: (703) 308-9797

Facsimile: (703) 305-0942

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 104,645.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

A handwritten signature in cursive script, reading "Sally C. Medley", written over a horizontal line.  
SALLY C. MEDLEY  
Administrative Patent Judge

The opinion in support of the decision being  
entered today is not binding precedent of the Board.

Paper 1

Filed by: Sally C. Medley  
Administrative Patent Judge  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

Filed 8 December 2000

MAILED

UNITED STATES PATENT AND TRADEMARK OFFICE

DEC 8 - 2000

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

YULUN WANG, DARRIN R. UECKER, CHARLES S. JORDAN,  
JAMES W. WRIGHT, KEITH PHILLIP LABY, and JEFF D. WILSON

Junior Party,  
(Patent 5,855,583),

v.

PHILIP S. GREEN

Senior Party  
(Application 08/709,930).

Patent Interference No. 104,645

**NOTICE DECLARING INTERFERENCE**  
(37 CFR § 1.611)

**Part A. Declaration of interference**

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Details of the application(s), patent (if any), reissue  
application (if any), count(s) and claims designated as  
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Parts E and F of this NOTICE DECLARING INTERFERENCE.

**Part B. Judge designated to handle the interference**  
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**Part C. Standing order**

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**Part E. The parties involved in this interference are:**

Junior Party

Named inventors: Yulun Wang, Goleta, CA  
Darrin R. Uecker, Santa Barbara, CA  
Charles S. Jordan, Santa Barbara, CA  
James W. Wright, Santa Barbara, CA  
Keith Phillip Laby, Santa Barbara, CA  
Jeff D. Wilson, Santa Barbara, CA

Patent: U.S. Patent 5,855,583,  
granted 5 January 1999,  
based on application 08/755,063,  
filed 22 November 1996

Title: Method and apparatus for performing  
minimally invasive cardiac procedures

Assignee: Company Motion, Inc.

Accorded Benefit: Patent 5,762,458, granted  
9 June 1998, based on  
Application 08/603,543,  
filed 20 February 1996

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: Philip S. Green, redwood City, CA

Application: Application 08/709,930  
filed 9 September 1996

Title: Surgical method

Assignee: None

Accorded Benefit: Application 07/823,932,  
filed 21 January 1992

Attorneys: See last page

Address: See last page

Part F. Counts and claims of the parties

Count 1<sup>1</sup>

Claim 119 of 08/709,930

or

Claim 3 of 5,855,583

The claims of the parties are:

Wang: 1-15

Green: 115, 118-126, 138, 139, 141 and 144

The claims of the parties which correspond to Count 1 are:

Wang: 1-6, 8-11 and 13-15

Green: 118-126

The claims of the parties which do not correspond to Count 1 are:

Wang: 7 and 12

Green: 115, 138, 139, 141, and 144

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<sup>1</sup> The examiner proposed the count to be claim 118 of 08/709,930 (claim 1 of 5,855,583). However, the examiner has indicated that claim 118 is unpatentable. Therefore, the count is based on the interfering subject matter that is patentable to both parties.

**Part G. Heading to be used on papers**

The following heading shall be used on papers filed in the interference. See § 18 of the STANDING ORDER.

Paper \_\_\_\_\_<sup>2</sup>

Filed on behalf of [name of party]

By: Name of lead counsel, Esq.

Name of backup counsel, Esq.

Street address

City, State, and Zip-Code

Tel:

Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

(Administrative Patent Judge Sally C. Medley)

YULUN WANG, DARRIN R. UECKER, CHARLES S. JORDAN,  
JAMES W. WRIGHT, KEITH PHILLIP LABY, and JEFF D. WILSON

Junior Party,  
(Patent 5,855,583),

v.

PHILIP S. GREEN

Senior Party  
(Application 08/709,930).

Patent Interference No. 104,645

TITLE OF PAPER

<sup>2</sup> Leave a blank line because the board assigns the paper number.

#### Part H. Summary of dates for taking action

Times for taking action are set out in the following sections of the STANDING ORDER:

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7. § 21: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
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9. § 33: date for objecting to admissibility of evidence.
10. § 34: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11. § 35: dates when cross-examination can take place.
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Part I. Order form for requesting file copies

FILE COPY REQUEST

Interference 104,645

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Telephone, including area code: \_\_\_\_\_

Part J. Signature of administrative patent judge

  
SALLY C. MEDLEY  
Administrative Patent Judge

Date: 12/8/00  
Arlington, VA

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in  
the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in  
the testimony and briefing phases of the interference  
(ORDERTE6)

PTO Form 850 and statement by examiner

Copy U.S. Patent 5,855,583

Copy of claims of Green application 08/709,930

DECLARE.007  
Revised September, 2000  
(replaces DECLARE.006.1)

cc (via Federal Express):

Attorney for Wang:

Kenneth L. Stein  
Computer Motion  
130-B  
Cremona Drive  
Goleta, CA 93117

Attorney for Green:

Townsend and Townsend  
Two Embarcadero Center  
8th Floor  
San Francisco, CA 94111-3834



## INTERFERENCE DIGEST

Interference No. 104,645

Paper No. 40

Name: Philip S. Green

Serial No.: 08/709,930

Patent No.

Title: SURGICAL METHOD

Filed: 09/09/96

Interference with Wang et al.

### DECISION ON MOTIONS

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

### FINAL DECISION

Board of Patent Appeals and Interferences, Favorable Dated, 5/28/02

\_\_\_\_\_  
Court, \_\_\_\_\_ Dated, \_\_\_\_\_

### REMARKS

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

This should be placed in each application or patent involved in interference in addition to the interference letters.